

either or both of the following can be shown: (1) that the process as *claimed* is not an obvious process of making the product and the process as *claimed* can be used to make other and different products, or (2) that the product as *claimed* can be made by another and materially different process.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

Group I (claims 1-5 & 12-16) contains method claims for producing stable cell lines of multipotential neural precursor cells following transfection with c-myc constructs. Group II (claims 6-8 & 17-19), Group III (claims 9, 11, 20 & 22) and Group IV (claims 10 & 21) contain claims for cell lines produced by the methods of Group I.

Thus, Group I is a process of making and Groups II, III and IV are products made by the process. However, the Examiner has failed to show that the process of Group I is not an obvious process of making the product and that the

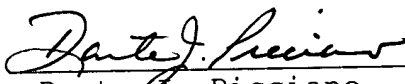
process of Group I can be used to make other and different products, or (2) that the product of Groups II, III or IV can be made by another and materially different processes.

Therefore, the burden shifts to the Examiner to document a viable alternative process of Group I or product of Groups II, III and IV, or withdraw the requirement.

Should any matters remain in this application which might be resolved by interview, the Examiner is requested to telephone the undersigned at (570) 386-5744.

Respectfully submitted,

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